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PTO/SB/21 (08-00)
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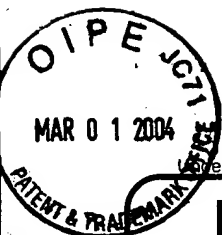
TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/557,149
	Filing Date	Apr 25, 2000
	First Named Inventor	Yohanan
	Group Art Unit	2174
	Examiner Name	SAX, STEVEN PAUL
Total Number of Pages in This Submission	Attorney Docket Number	MS1-1074USC3

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) Sheets <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcard
Remarks		RECEIVED MAR 08 2004 Technology Center 2100

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Firm or Individual name	Brian J. Pangre, Reg. No. 42,973
Signature	
Date	3/1/2004

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I hereby certify that the items listed above as enclosed are being deposited with the U.S. Postal Service as Express Mail, in an envelope addressed to The Commissioner of Patents, Alexandria, VA 22313 on the below-indicated date. The Express Mail No. has also been marked on the listed items. Express Mail No. EV369763615		
Typed or printed name	Garly E. Taylor	
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EV369763015

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 330.00

Complete if Known

Application Number	09/557,149
Filing Date	Apr 25, 2000
First Named Inventor	Yohanan
Examiner Name	SAX, STEVEN PAUL
Art Unit	2174
Attorney Docket No.	MS1-1074USC3

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METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit Account Number
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12-0769

Lee & Hayes, PLLC

The Director is authorized to: (check all that apply)

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$ 0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below		Fee Paid
Total Claims	<input type="text"/>	-20** =	<input type="text"/>	X	<input type="text"/>	
Independent Claims	<input type="text"/>	-3** =	<input type="text"/>	X	<input type="text"/>	<input type="text"/>
Multiple Dependent					<input type="text"/>	<input type="text"/>

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ 0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

MAR 08 2004

3. ADDITIONAL FEES

Large Entity

Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
1051	130	2051	65	Surcharge - late filing fee or oath
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet
1053	130	1053	130	Non-English specification
1812	2,520	1812	2,520	For filing a request for ex parte reexamination
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action
1251	110	2251	55	Extension for reply within first month
1252	420	2252	210	Extension for reply within second month
1253	950	2253	475	Extension for reply within third month
1254	1,480	2254	740	Extension for reply within fourth month
1255	2,010	2255	1,005	Extension for reply within fifth month
1401	330	2401	165	Notice of Appeal
1402	330	2402	165	Filing a brief in support of an appeal
1403	290	2403	145	Request for oral hearing
1451	1,510	1451	1,510	Petition to institute a public use proceeding
1452	110	2452	55	Petition to revive - unavoidable
1453	1,330	2453	665	Petition to revive - unintentional
1501	1,330	2501	665	Utility issue fee (or reissue)
1502	480	2502	240	Design issue fee
1503	640	2503	320	Plant issue fee
1460	130	1460	130	Petitions to the Commissioner
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)
1806	180	1806	180	Submission of Information Disclosure Stmt
8021	40	8021	40	Recording each patent assignment per property (times number of properties)
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))
1801	770	2801	385	Request for Continued Examination (RCE)
1802	900	1802	900	Request for expedited examination of a design application

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 330.00

SUBMITTED BY

(Complete if applicable)

Name (Print/Type)	Brian J. Pangre	Registration No. (Attorney/Agent)	42,973	Telephone	(509) 324-9256
Signature		Date	2/1/2004		

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This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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EV369763615

#27
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/557,149
Filing DateJuly 9, 1999
InventorshipYohanan
5 Assignee Microsoft Corporation
Group Art Unit..... 2174
Examiner S. Sax
Attorney's Docket No.MS1-1074USC3
10 Title: Graphical Method and System for Accessing Information on a
Communications Network

REPLY BRIEF TO THE BOARD OF PATENT APPEALS AND
INTERFERENCES OF THE UNITED STATES PATENT OFFICE FILED IN
RESPONSE TO THE EXAMINER'S ANSWER

15 To: Commissioner for Patents
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From: Brian J. Pangrle
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421 W. Riverside Avenue, Suite 500
20 Spokane, WA 99201

Technology Center 2100

Appellant's Reply Brief on Appeal

This reply brief is presented in support of the Notice of Appeal filed on
May 12, 2003 from the final rejection of claims 3-12 of the above identified
25 application and in support of Appellant's Opening Brief, filed on October 14,
2003. The Final Office Action which Appellant hereby appeals was mailed
March 12, 2003.

The Reply Brief is filed in triplicate. Please charge any additional
required fees or credit overpayment to Deposit Account 120769. Appellant
30 respectfully requests reversal of the Office's rejection of pending claims 3-12.

Reply Argument

Acknowledgement of Appellant's Opening Brief's conformity with formalities is appreciated. Arguments are presented below in accordance with
5 the Examiner's Answer mailed December 29, 2003, as presented under the heading "Response to Argument".

Appellant notes that the Examiner's Answer bears an incorrect date stamp of **December 29, 2001** and that formatting errors have resulted in some words being partially or wholly deleted.

10

Temporal Perspective – Relevant Dates

The Examiner's Answer states that "the patents over which the current
103 rejection was made date back to well before January of 1995, and thus the timing for obviousness is temporally consistent" (Examiner's Answer at page 3).
15 For ease of reference, and to establish a proper temporal perspective, Appellant presents specific dates below.

The Doyle patent (U.S. Pat. No. 5,838,906) was filed on October 17, 1994. This is less than two and a half months prior to January 1995. Further the parent application to the instant application (U.S. Pat. No. 5,737,560)
20 included an unredacted email as part of an affidavit filed pursuant to 37 CFR 1.131 (see Image 1, below). In the affidavit, the applicant (Silicon Graphics, Inc.) of the instant (now Microsoft Corporation) application claimed a date of November 22, 1994. This is approximately one month after the filing date of the Doyle patent. Appellant submits that a proper timeline must be established to
25 avoid improper hindsight reconstruction – noting that an obviousness analysis under §103 includes a myriad of factual inquiries.

With respect to the Cardinal patent (U.S. Pat. No. 5,799,318), the priority date is April 13, 1993, which is just over one and a half years prior to January 1995. As in any legal or administrative proceeding, where quantitative
30 information is available, it should be relied upon instead of qualitative

statements regarding time. Thus, for this particular Appeal, the relevant date for the Cardinal patent should be April 13, 1993 and, for the Doyle patent, it should be October 17, 1994. The relevant date for the instant application should be November 22, 1994 per the evidence submitted in the affidavit of the
5 parent application (see also Image 1, below).

Motivation - Problem to be Solved

Regarding motivation to combine references, the Examiner's Answer states:

10 The motivation to combine references lies in convenient resources to which data objects may be linked – both references have that. Then Doyle et al shows a convenient example of the resource being the web. Cardinal et al show the launching of the browser which links to data objects, and Doyle et al show the links to the web.

15 Examiner's Answer at pages 3, 4.

Appellant disagrees and reiterates that there is no suggestion to modify the cited prior art and that even assuming that such a suggestion existed, one of ordinary skill in the art would not arrive at the claimed subject matter. For these reasons alone, Appellant asserts that the Office has failed to make a
20 prima facie case of obviousness.

Further, even if a prima facie case of obviousness has been established, the Office must weigh secondary considerations presented by an applicant, which can include evidence of factors tending to show nonobviousness, such as commercial success of the invention, satisfying a long-felt need, failure of
25 others to find a solution to the problem at hand, and copying of the invention by others. See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). To this end Appellant submits that the prosecution histories of the instant application and its related cases (U.S. Pat. Nos. 5,737,560; 5,877,767; 6,072,491) include evidence sufficient to
30 demonstrate nonobviousness of the claimed subject matter and to overcome

any prima facie obviousness rejection based on the Cardinal reference and the Doyle reference.

With respect to these foregoing bases for reversal, Appellant submits that one may look to the "problem to be solved" to realize that (i) there is no
5 suggestion to modify the cited prior art, (ii) modification of the cited prior art would not lead to the claimed subject matter and (iii) evidence germane to secondary considerations overwhelmingly demonstrate nonobviousness of the claimed subject matter.

The problem to be solved has been stated succinctly in the prosecution
10 history. Image 1, below, is a scanned copy of an unredacted email submitted as an attachment to a Declaration under 37 CFR §1.131 on April 30, 1996 in parent case 08/580,742 (U.S. Pat. No. 5,737,560). This email is not new evidence as discussed under MPEP §1208.03 as it is part of the prosecution history of the instant application and the parent application. This email is
15 provided herein to facilitate review of this Appeal. A redacted copy of this email was submitted in the instant application on November 17, 2001; thus, the text of the email is also part of the intrinsic record of the instant application.

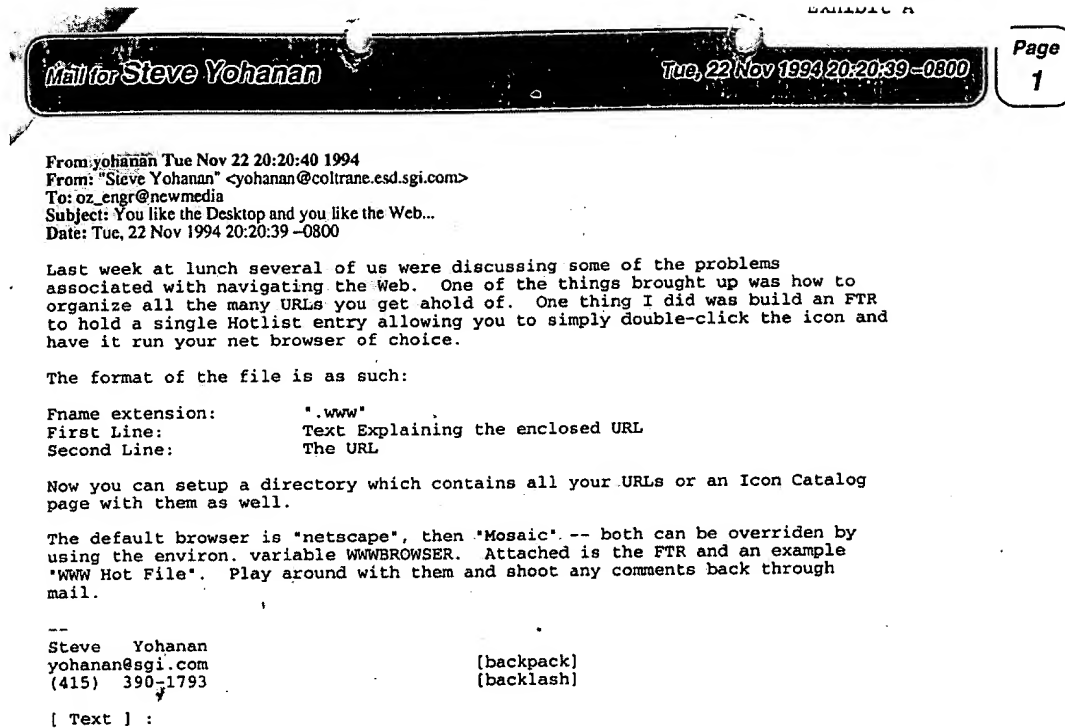
20

25

30

IMAGE 1

5



Under the "Subject" heading, the email reads "You like the Desktop and you like the Web . . . ", which may be viewed as a scope of subject matter. The
10 message body then states "[L]ast week at lunch several of us were discussing some of the problems associated with navigating the Web" and "[O]ne of the things brought up was how to organize all the many URLs you get ahold of." The inventor then states "One thing I did was build an FTR to hold a single Hotlist entry allowing you to simply double-click the icon and have it run your
15 net browser of choice."

From this evidence, the nature of the problem to be solved is associated with navigating the Web and organizing URLs and the scope of the solution

includes the desktop and the Web. In contrast, as stated in the Examiner's Answer at page 3, the nature of the concocted problem appears to be associated with linking convenient resources and data objects (i.e., "convenient resources to which data objects may be linked") and the scope appears to be
5 very broad and with little limit. In general, as the scope of a problem broadens, the evidence to show a motivation to combine the disparate references becomes more tenuous.

To properly address the issues presented herein, Appellant submits that the Office should consider the correct problem, in nature and scope, and, in so
10 doing, it should rely on the evidence of record, primarily the hand of inventor Yohanan. Indeed, without the correct problem how could one judge failure of others to find a solution to the problem at hand? How could one find a motivation?

Importantly, given the correct problem, Appellant submits that there is no
15 motivation to combine the Cardinal reference and the Doyle reference. The Cardinal reference does not mention the Web and the browser that the Cardinal reference does mention is simply not a Web browser. Appellant can only ponder how one of ordinary skill in the art would view the Cardinal reference given the correct problem. Which begs the question, what would motivate one
20 to read the Cardinal reference? And, if one did read it, what would he or she learn about Web browsers, URLs, navigating the Web? Little to nothing.

With respect to the Doyle reference, one of ordinary skill in the art may be expected to learn about modifying Web browser software to parse hypermedia and hypertext documents. As for navigating the Web, Appellant
25 fails to see how the Doyle reference teaches anything about such navigation – i.e., getting from one place to another. In contrast, the instant application provides a clever solution to navigate the Web whereby a user may simply click on a desktop icon.

For at least the foregoing reasons, Appellant submits that the rejected claims are allowable over the cited references and that the decision of the Examiner should be reversed.

5 Evidence of Secondary Considerations

Appellant submits that the strongest evidence came from the hand of the inventor when he solved the problem addressed by his colleagues. Appellant submits that Silicon Graphics, Inc. played an important role in the development of computers and software and that the current assignee has played an
10 important role in the development of computers, software and the Web. Indeed, today, the widespread use of desktop icons to launch a Web browser and to navigate to a Web site demonstrates commercial success.

Further, the prosecution histories show a heightened level of due diligence by both original assignee Silicon Graphics, Inc. and current assignee
15 Microsoft Corporation. On April 30, 1996, original applicant and assignee Silicon Graphics, Inc. filed a Petition to Make Special under 37 CFR §1.102(d) along with a detailed information disclosure statement stating that "a thorough and careful search was conducted in the United States Patent and Trademark Office (PTO)" wherein Supervisory Patent Examiner (SPE) Heather Herndon
20 and Examiner John Breene of Art Group 2400 and SPE Thomas Lee of Art Unit 2317 were consulted regarding the search. The original applicant/assignee even went further and conducted a keyword computer database search in the "USPAT" file and the "JPO" file of the Automated Patent System (APS). In addition, an on-line search of the internet was performed.

25 The current assignee, Microsoft Corporation, recognized that the duty of disclosure transferred as a result of the assignment. In response, Microsoft Corporation queried developers of operating systems such as the WINDOWS 95® operating system as to their knowledge of any related art. As a result of this search, a supplemental IDS was filed on July 12, 2002. The art included
30 information regarding operating systems that predated the WINDOWS 95®.

The art also included an article dated August 17, 1995, which stated "users can go from their desktops to any of their favorite Web sites just by clicking a single icon, without having to launch their connectivity software separately . . . and navigate to the desired Web sites." (emphasis added) from document "Microsoft

5 Introduces Internet Explorer, Internet Browser Designed Specifically for Windows 95 Offers Customers Easy Access to the Internet", August 17, 1995, submitted in Supplemental IDS dated July 12, 2002.

Appellant has emphasized the word "navigate" for this was the word used at or near the time of invention of the claimed subject matter. Again, this
10 evidence demonstrates that the problem to be solved and solved by inventor Yohanan was associated with navigation of the Web. The Cardinal reference simply does not address navigation of the Web and the Doyle reference is directed to modification of Web browser software for hypertext and hypermedia documents not to methods of Web navigation.

15 This evidence supports nonobviousness of the claimed subject matter. In particular, it is evidence of commercial success of the invention, evidence of satisfying a need perceived by highly skilled developers at Silicon Graphics, and perhaps even evidence of copying of the invention by others.

20 Claim Groups

Group I: Appellant submits that the foregoing presentation of arguments and citation of evidence of record provide sufficient bases for reversal of the Examiner's decision with respect to claims 3, and 9-12, which recite a desktop icon on a desktop associated with an address of a web site wherein selection of
25 the desktop icon by a user launches a web browser application that can access the web site using the address. Appellant reiterates that (i) there is no suggestion to modify the cited prior art, (ii) modification of the cited prior art would not lead to the claimed subject matter and (iii) evidence germane to secondary considerations overwhelmingly demonstrate nonobviousness of the
30 subject matter of claims 3 and 9-12.

Group II: Appellant submits that the foregoing presentation of arguments and citation of evidence of record provide sufficient bases for reversal of the Examiner's decision with respect to claim 4, which recites a desktop icon
5 associated with a file containing information relating to a web site accessible via a web browser application wherein the web browser application is separate from the file. The Cardinal reference does not mention the Web and hence does not disclose, teach or suggest anything about a file containing information relating to a web site. Appellant reiterates that (i) there is no suggestion to
10 modify the cited prior art, (ii) modification of the cited prior art would not lead to the claimed subject matter and (iii) evidence germane to secondary considerations overwhelmingly demonstrate nonobviousness of the subject matter of claim 4.

15 Group III: Appellant submits that the foregoing presentation of arguments and citation of evidence of record provide sufficient bases for reversal of the Examiner's decision with respect to claim 5, which is an independent claim directed to a graphical computer system for accessing a desired document located at a network location. Claim 5 recites retrieving the desired document
20 from a network location using a web browser application and a network address via selection of a desktop icon associated with a file containing the network address that corresponds to the network location of the document wherein the web browser application is separate from the file. The Cardinal reference does not mention the Web and hence does not disclose, teach or suggest anything
25 about a Web browser application separate from a file containing a network address that corresponds to the network location of a document. Appellant reiterates that (i) there is no suggestion to modify the cited prior art, (ii) modification of the cited prior art would not lead to the claimed subject matter and (iii) evidence germane to secondary considerations overwhelmingly
30 demonstrate nonobviousness of the subject matter of claim 5.

Group IV: Appellant submits that the foregoing presentation of arguments and citation of evidence of record provide sufficient bases for reversal of the Examiner's decision with respect to claims 6, 7 and 8. Claim 6 is an
5 independent claim while claims 7 and 8 depend on claim 6. Claim 6 is directed to a method. Claim 6 recites receiving a desktop icon associated with a file from a second computer system wherein the file contains an address corresponding to a web site. Claim 7 recites receiving an email while claim 8 recites receiving an internet message. The Cardinal reference does not
10 mention the Web and does not disclose, teach or suggest anything about receiving a desktop icon associated with a file from a second computer system wherein the file contains an address corresponding to a web site. Appellant reiterates that (i) there is no suggestion to modify the cited prior art, (ii) modification of the cited prior art would not lead to the claimed subject matter
15 and (iii) evidence germane to secondary considerations overwhelmingly demonstrate nonobviousness of the subject matter of claims 6, 7 and 8.

Conclusion

It is respectfully submitted that the cited art does not render the claimed
20 invention obvious and that therefore the claimed invention does patentably distinguish over the cited art. Further, various evidence of record supports non-obviousness of the subject matter of claims 3-12 (e.g., Declaration, Petition and articles on INTERNET EXPLORER® software). It is respectfully submitted that claims 3-12, as set forth in Groups I, II, III and IV, should therefore be allowed.
25 The Office has not made a prima facie case of obviousness for any of these Groups, in the alternative, assuming arguendo that a prima facie case has been established, evidence germane to secondary considerations supports nonobviousness and is sufficient to overcome such a prima facie case. Therefore, reversal of the Office's rejections of claims 3-12 is respectfully
30 requested.

5

Dated:

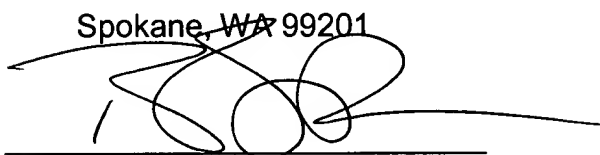
3/1/2004

Respectfully Submitted,

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A handwritten signature in black ink, appearing to read 'Brian J. Pangrle', written over a horizontal line.

Name: Brian J. Pangrle

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10

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